

REMARKS

This is a full and timely response to the outstanding Final Office Action mailed March 23, 2004. Upon entry of the amendments in this response, claims 1 – 2, 4 – 12, 14 – 22, and 24 – 37 remain pending. In particular, Applicants have added claims 31 – 37, and have amended claims 1, 11 and 21. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

The Office Action indicates that claims 1 - 2, 4 - 12, 14 - 22, and 23 - 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Shaughnessy* or *Ng*. For at least the reasons indicated below, Applicants respectfully traverse the rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration.” W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in either the *Shaughnessy* or *Ng* reference. Specifically, claim 1 recites:

1. A system comprising:
a scanner;
a document analysis and processing software component in communication with said scanner; and
automatic annotation logic in communication with said document analysis and processing software component, said automatic annotation logic configured to detect handwriting in a scanned image and save said handwriting as an annotation in a document generated from said scanned image such that, when a preview image corresponding to the scanned image is displayed to a user via a display device, the annotation is not automatically displayed to the user.
(Emphasis Added).

Applicants respectfully assert that neither reference teaches or otherwise discloses at least the features/limitations emphasized above in claim 1. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102 is improper and that claim 1 is in condition for allowance. Since claims 2 – 10 are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance.

Claim 11 recites:

11. A method comprising:
scanning a document to acquire a scanned image;
detecting handwriting in said scanned image; and
modifying said scanned image to remove said handwriting from the scanned image such that the handwriting is not automatically displayed to an operator viewing the scanned image via a display device, the handwriting being saved as an annotation associated with said scanned image, the annotation being selectively viewable by the operator.
(Emphasis Added).

Applicants respectfully assert that neither reference teaches or otherwise discloses at least the features/limitations emphasized above in claim 11. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102 is improper and that claim 11 is in condition for allowance. Since claims 12 and 14 - 20 are dependent claims that incorporate

all the features/limitations of claim 11, Applicants respectfully assert that these claims also are in condition for allowance.

Newly Added Claims

Upon entry of the amendments in this Response, Applicants have added new claims 31 - 37. Applicants respectfully assert that these claims are in condition for allowance for at least the reasons indicated below.

With respect to claim 31, that claim recites:

31. A system for processing a document that includes a notation, said system comprising:
analysis and processing logic operative to:
receive information corresponding to a scanned document;
determine whether the information comprises a notation; and if a notation is identified, process the information such that, when a preview image corresponding to the scanned document is displayed to the user on a display device, the notation is not automatically displayed to the user.
(Emphasis Added).

Applicants respectfully assert that the cited art of record, either individually or in combination, is legally deficient for the purpose of anticipating and/or rendering obvious at least the features emphasized above in claim 31. Therefore, Applicants respectfully assert that claim 31 is in condition for allowance. Since claims 32 - 37 depend from claim 31, Applicants respectfully assert that these claims also are in condition for allowance.

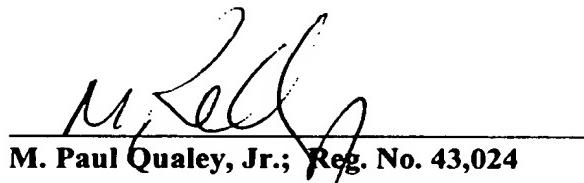
Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments, Applicants respectfully submit that pending claims 1 – 2, 4 – 12, 14 – 22, and 24 - 37 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this application, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on

5/6/04

Stephanie Riley
Signature